



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,085	01/18/2001	Tomoshi Hirayama	204685US6	6133

7590 04/07/2005

Oblon Spivak McClelland Maier & Neustadt PC
1755 Jefferson Davis Highway Fourth Floor
Arlington, VA 22202

EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,085

Applicant(s)

HIRAYAMA, TOMOSHI

Examiner

Matthew R Demicco

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 10, 130.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 2, 34.
Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 5 is objected to because of the following informalities: "said transmission server section" should be corrected to read --a transmission server section--. Appropriate correction is required.

Art Unit: 2611

4. Claim 11 is objected to because of the following informalities: "the new arrangement prepared modifying" should be corrected to read --the new arrangement prepared **by** modifying-- . Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13, 15, 17, 20-21, 24, 34, 36-37, 41 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,029,045 to Picco et al.

Regarding Claim 1, Picco discloses an information providing system comprising a transmission server section (See Figure 3, 102) for transmitting a continuous stream of contents data of a group of multimedia contents (Col. 6, Lines 1-7) including prearranged combinations of program main body data (live television signals) and groups of auxiliary materials (local content signals). Further disclosed are terminal sections (See Figure 7, 120) for receiving the continuous stream of contents data transmitted from said transmission server section (Col. 6, Lines 17-23), the terminal sections being provided with an arrangement control function of preparing a new arrangement by modifying the arrangement order of the contents data (Col. 6, Lines 23-29) by processing the attribute

Art Unit: 2611

data (Col. 6, Line 57 – Col. 7, Line 2 and Col. 8, Lines 7-20) of each program main body data (television program) and that of each auxiliary material of a program (local programming such as advertising) as separated from each other as well as the profile data of the user and that of the user device (Col. 7, Lines 6-30 and Col. 7, Line 55 – Col. 8, Line 22).

Regarding Claim 2, Picco discloses a system as stated above in Claim 1, wherein each of said terminal sections has an on-demand control function of requesting additional contents data on an on-demand basis (Col. 9, Lines 58-60 and Col. 10, Lines 39-40). A user profile is used to determine which local contents are actually to be stored and subsequently inserted in the television programming (Col. 10, Lines 4-10). This reads on the claimed taking in said additional contents data (local content for storage) on the basis of the result obtained by processing said attribute data (Col. 6, Line 59 – Col. 7, Line 2) and said profile data as stated above.

Regarding Claim 3, Picco discloses a system as stated above in Claim 1, wherein the terminals are operable to store user profile data including data about which contents were watched, and periodically communicate that information to a collection system (Col. 7, Lines 6-23). Because this information is collected at the terminals for a particular duration of time, and because the information is dynamic, this reads on the claimed each of said terminal sections having a memory means adapted to temporarily replace the profile data with some other profile data.

Regarding Claim 4, Picco discloses a system as stated above in Claim 1, wherein each terminal is operable to report the collected profile data to the head-end server as

stated above. This reads on the claimed function of notifying the transmission server section of the result of reproducing the contents data according to the new arrangement prepared by means of the arrangement control function (which commercials were selectively inserted and displayed to the viewer). Upon receiving this statistical data from a plurality of terminals, the server is operable to distill aggregate statistics of which ads have been viewed (Col. 7, Lines 18-32). This reads on the claimed transmission server having a management function of settling the accounts (compiling the collected user data) on the basis of the result of reproducing the contents data according to the new arrangement as notified from the terminal section as stated above.

Regarding Claims 5-8, see Claims 1-4 above respectively.

Regarding Claims 9-11, see Claims 1-2 and 4 above, respectively.

Regarding Claim 12, Picco discloses an information providing system comprising a transmission server section for transmitting a continuous stream of contents data of a group of multimedia contents and auxiliary materials as stated above in Claim 1. Further, sorting information including content profiles, unique content identifier codes, time, use statistics and utilization directives are transmitted along with the content (Col. 6, Lines 57-67) that is multiplexed together with the live television signals (Col. 5, Lines 2-5 and Col. 6, Lines 2-7). Further, the information received by the terminal may include a distribution variable (Col. 7, Lines 56-61) that identifies a specific user's terminal to store content (Col. 8, Lines 4-6). This reads on the claimed main body data (television programming) prepared with sorting information along with terminal ID information annexed thereto. Further disclosed are terminal sections having a function of receiving

the continuous stream of contents data transmitted from said transmission server section as stated above in Claim 1. The terminals are further operable to transmit back to the server collected statistical information about which ads were watched. Because these ads are uniquely identified by the sorting information transmitted therewith, this reads on the claimed transmitting the sorting information that was annexed to the program main body data and the auxiliary materials to be reproduced. Picco further discloses a processing server section for sending the revision assisting materials (Col. 7, Lines 33-48) corresponding to the auxiliary materials (local content) combined with the program main body data (television programming) as stated above. The local content is reproduced by appropriate terminal sections on the basis of the sorting information and the distribution variables that target specific terminal IDs as stated above. Because a specific terminal may be targeted for storage and subsequent insertion of an advertisement based on a profile sent to the head-end, it is inherent that the terminal must transmit its identification to the head-end along with the stored profile data. This reads on the claimed terminal ID information transmitted from the terminal sections.

Regarding Claim 13, Picco discloses a system as stated above in Claim 12, wherein the sorting information contains unique identification codes, viewing times, expiration times, and insertion channel information (Col. 6, Lines 59-67). This reads on the claimed sorting numbers allocated so as to unequivocally indicate the positions for inserting the auxiliary materials in the program.

Regarding Claim 15, Picco discloses a system as stated above in Claim 12, wherein the terminals are operable to record the local content data for later playback

Art Unit: 2611

(Col. 6, Lines 23-29) as well as the television programming (Col. 13, Lines 24-32). This reads on the claimed terminal sections having a recording function of recording the program main body data (television programming) and auxiliary materials (local content) received by the terminal section. Further disclosed is a recording function of recording the sorting information annexed to the program main body and the auxiliary materials (Col. 11, Lines 35-38).

Regarding Claim 17, see Claim 12 above.

Regarding Claim 18, see Claim 15 above.

Regarding Claims 20-21, see Claims 12-13 above, respectively.

Regarding Claim 24, see Claims 12 and 15 above. Picco further discloses that the server is operable to use the viewing statistics to generate and transmit to the terminal a command to update the stored contents (Col. 7, Lines 33-41). This reads on the claimed processing server section for detecting any change to be made to the auxiliary materials combined with the selected program main body data (determining when new content is to be stored on a terminal) and upon detecting the change, issuing an instruction for the change to be made to the materials to the related terminal.

Regarding Claim 34, see Claims 12 and 15 above.

Regarding Claim 36, Picco discloses a system as stated above in Claim 34, wherein the terminals have a function of receiving the instruction for change to be made to the materials from the server as stated above. It is inherent that such an instruction must be stored in memory in order for the computer device to act upon it. This reads on the claimed recording the instruction for the change before starting the reproduction of

Art Unit: 2611

the materials or reediting the contents data (updating the stored information) according to the instruction for the change.

Regarding Claim 37, see Claim 12 above. Picco further discloses a system wherein the server detects any materials to be added to the terminal as stated above in Claim 24 according to the sorting information and terminal ID information from the terminal as stated above in Claim 12. The server then notifies the terminal of the materials to be added (new local data to be stored).

Regarding Claim 41, Picco discloses a system as stated above in Claim 37, wherein the server is operable to aggregate the profile data from a plurality of terminals as stated above. This reads on the claimed processing server carrying out an operation of adding up the contents reproduced at the terminal section according to the sorting information and the terminal ID information transmitted from the terminal section as stated above.

Regarding Claim 44, see Claims 12, 15 and 24 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14, 16, 19, 22-23, 25-33, 35, 38-40, 42-43, 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al.

Regarding Claim 14, Picco discloses a system as stated above in Claim 12. What is not disclosed, however, is that the sorting information contains a return address identifying the location of the processing server section. Official Notice is hereby taken that is well known in the art that a data packet transmitted by a device on a network to another device may include the address of the sender. This reads on the claimed return address identifying the location of the processing server section. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the transmission system with return path of Picco to include the sender address of the well-known prior art in order to facilitate authentication of the command data as originating from an authorized sender as well as proper back-channel addressing.

Regarding Claim 16, Picco discloses a system as stated above in Claim 12, wherein the terminal sections are adapted to return a profile to the head-end server that contains a list of programming viewed as well as a terminal identification as stated above. This reads on the claimed terminals adapted to return the program sorting numbers (identification of programs watched) contained in the sorting information along with the terminal ID information to the processing server. What is not disclosed, however, is that the processing server section is specified by the return address contained in the sorting information. Picco in view of the well-known prior art disclose including the sender address as stated above in Claim 14.

Regarding Claim 19, see Claim 16 above.

Regarding Claims 22-23, see Claims 14 and 16 above, respectively.

Regarding Claim 25, Picco discloses a system as stated above in Claim 24, wherein the terminals have a function of receiving instructions for the change to be made to the auxiliary materials from the processing server as stated above. What is not disclosed, however, is sending back the conditions for the instruction for the change and an acknowledgement or refusal of the change. Official Notice is hereby taken that it is well known in the art that a device may generate an acknowledgement or failure message and the conditions thereof in response to an instruction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Picco with the terminal response of the well-known prior art in order to inform the server that a particular storage request can or cannot be fulfilled and the condition, such as, for example if the terminal's hard disk drive were full, such that the server would know to try the request again later or to issue a delete command to free up space.

Regarding Claims 26-27, Picco discloses a system as stated above in Claim 25, wherein the terminals have a function of receiving the instruction for change to be made to the materials from the server as stated above. It is inherent that such an instruction must be stored in memory in order for the computer device to act upon it. This reads on the claimed recording the instruction for the change before starting the reproduction of the materials or reediting the contents data (updating the stored information) according to the instruction for the change.

Regarding Claim 28, Picco discloses a system as stated above in Claim 25, wherein the server detects the existence of revision assisting materials and notifies the

terminal section of the existence of the revision assisting materials. As stated above in Claim 25, an acknowledgement or failure message is received from the terminal in response to the request. It is inherent that the server would not send the revision materials (new local data to be stored) to the terminal without receiving the acknowledgement. This reads on the claimed upon receiving an acknowledgement for reception, sending the revision assisting materials and the instructions for the revision to the terminal section.

Regarding Claim 29, Picco discloses a system as stated above in Claim 25, wherein the server detects any materials to be added to the terminal as stated above in Claim 24 according to the sorting information and terminal ID information from the terminal as stated above in Claim 12. The server then notifies the terminal of the materials to be added (new local data to be stored). It is inherent that the server would not send the assisting materials to the terminal without receiving the acknowledgement. This reads on the claimed upon receiving an acknowledgement for reception, sending the assisting materials to be added and the instructions for the addition to the terminal section.

Regarding Claim 30, Picco discloses a system as stated above in Claim 25, wherein the server may detect changes in the auxiliary materials to be sent to a terminal and send a command and the appropriate materials to the terminal as stated above. What is not disclosed, however, is that the server may detect materials to be omitted and notifies the terminal of the materials to omit. Official Notice is hereby taken that it is well known in the art that a server may instruct a terminal to delete stored data. This reads on the claimed detecting and notifying the terminal of materials to be omitted. Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Picco with the server deletion command of the well-known prior art in order to allow the service provider to remove from circulation a piece of content that has expired, is no longer relevant, or was not meant to be distributed. Further, an acknowledgement for reception is disclosed which leads to the transmission of the command as stated above.

Regarding Claim 31, Picco discloses a system as stated above in Claim 25, wherein the server is operable to aggregate the profile data from a plurality of terminals as stated above. This reads on the claimed processing server carrying out an operation of adding up the contents reproduced at the terminal section according to the sorting information and the terminal ID information transmitted from the terminal section as stated above.

Regarding Claim 32, Picco discloses a system as stated above in Claim 25. What is not disclosed, however, is that the server confirms the copying status of contents reproduced at the terminal. Official Notice is hereby taken that it is well known in the art that a data transmitter can confirm the status of a data transfer to a receiver. This reads on the claimed confirmation of copying status. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Picco with the copying status confirmation of the well-known prior art in order to detect errors and re-send the data as necessary.

Regarding Claim 33, see Claim 4 above.

Regarding Claim 35, see Claim 25 above.

Art Unit: 2611

Regarding Claims 38-39, see Claims 28-29 above, respectively.

Regarding Claim 40, see Claim 30 above.

Regarding Claim 42, see claim 32 above.

Regarding Claim 43, see Claim 33 above. Further, the output of the adding function may be communicated to other advertisers or sold to companies (Col. 7, Lines 23-28). This reads on the claimed outputting the result of the adding as settlement information.

Regarding Claims 45-53, see Claim 25-33 above, respectively.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 5,815,671 to Morrison discloses a system of providing programming and targeted messages with program break flags indicating a time and identity of messages to be inserted in program material as well as a queue of message positioning information.

b. U.S. Patent No. 6,425,127 to Bates et al. discloses a video stream with multiple commercial streams with ad identification and ad insertion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (571) 272-7293.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

Art Unit: 2611


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mf

mr

March 30, 2005


CHRIS GRANT
PRIMARY EXAMINER